

REMARKS

Claims 37-39 have been amended and are pending. A Petition for Extension of Time (three-months) is being filed concurrently herewith. Applicants reserve the right to pursue the original claims and other claims in this and other applications. Applicants respectfully request reconsideration of the above-referenced application in light of the amendments and following remarks.

Claims 37 and 38 stand objected to based on an informality. As requested by the Examiner, claims 37 and 38 have been amended to recite "view of the" rather than "view the." The Examiner's approval is solicited.

Claims 37 and 39 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,466,934 ("Adams"). The rejection is respectfully traversed.

The subject matter of claims 37 and 39, as amended, is not taught or disclosed in Adams. In particular, Adams does not teach an electron microscope or a method of observing a specimen in an electron microscope by "calculating a degree of coincidence of images obtained by differential optical conditions of the electron microscope," as recited in claims 37 and 39, respectively.

Adams does not disclose that the calculated degree of coincidence of images, obtained by differential optical conditions of the electron microscope, is applied to determine whether the field of view is suitable for observation. Adams merely discloses that EBSD analysis is conducted based on evaluating change between different points, and moves the beam to the next point based on the analysis (col. 6, line 58 – col. 7, line 5).

In contrast, Applicants' claimed electron microscope and method calculates the degree of coincidence of images obtained by differential optical conditions. The resulting calculation indicates whether the field of view of the electron microscope can acquire an image for observation. Adams does not disclose that the electron beam conditions are changed for acquiring an image. Accordingly, Adams does not teach the subject matter of amended claims 37 and 39.

Claim 38 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Adams in view of U.S. Patent No. 3,700,801 ("Dougherty"). The rejection is respectfully traversed.

For similar reasons provided above, the subject matter of claim 38, as amended, is not disclosed or suggested in Adams. Specifically, Adams does not teach or suggest an electron microscope that calculates "a degree of coincidence of images obtained by differential optical conditions of the electron microscope," as recited in claim 38. Adams does not disclose that the electron beam conditions are changed for acquiring an image. Dougherty is relied upon for a phase-only image correlation method to find differential data and adds nothing to rectify the deficiencies associated with Adams.

Moreover, Dougherty merely discloses a correlation technique between images. Dougherty does not disclose or suggest that the calculated degree of coincidence of images obtained by differential optical conditions of the electron microscope is applied to determine whether the field of view is suitable or not for observation. Accordingly, the cited references do not teach or suggest the subject matter of amended claim 38.

Claims 37-39 stand provisionally rejected under the non-statutory judicially created doctrine of obviousness-type double patenting over claims 1, 19, 20 and 21 of U.S. Patent Application No. 09/871,739 ("739 application"), filed on June 4, 2001, and which was allowed on June 1, 2004. In response, a Terminal Disclaimer is being filed concurrently herewith in regards to the '739 application. Accordingly, the non-statutory double-patenting rejection should be withdrawn.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to review and pass this application to issue.

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Respectfully submitted,

By 

Mark J. Thronson

Registration No.: 33,082

DICKSTEIN SHAPIRO MORIN &
OSHINSKY LLP

2101 L Street NW

Washington, DC 20037-1526

(202) 785-9700

Attorney for Applicants